

REMARKS

In addition to the request for continued examination concurrently filed, the applicants submit the following response to the new arguments presented in the advisory action dated November 6, 2008 relating to the obviousness rejections of claims 12, 18, 19, 24, 27-29, 30, 32, 35, and 36 and the refusal to admit the affidavit demonstrating invention prior to the effective filing dates of the Doyle, Jiang, and Murata references.

35 U.S.C. §103(a) Rejections

The arguments presented in the advisory action take issue with the language used in the applicants' previous response. Specifically, the phrases "the series of documents" and the "original set of documents" were targeted because they were "not even mentioned in independent claims 12 and 24." The new arguments also continue to maintain that the Koga reference discloses storing staple information for plural sheets which are "considered as a set of documents that is similar to the claim language."

Claims 12 and 24 clearly indicate, however, that the binding information and organizational data are stored for the original set of documents, not the physical copies of the documents generated by the Koga system. In the previous response, the applicants were merely attempting to point out to the examiner a distinguishing feature between the present invention and the Koga reference, specifically that the Koga reference does not disclose the long-term storage of binding information for the "collection of documents" recited in claim 12 or the "set of documents" in claim 24.

As discussed in paragraph [0040] of the applicants' specification, binding information is defined as information about binding elements associated with particular documents in a collection or set of documents, such as "paper clips, staples, folders, three-ring binders, boxes, dividers, rubber bands, prong fasteners, and spirals." This binding information is stored for the scanned documents, not for the physical copies as disclosed in the Koga reference. Additionally, as required by amended claims 12 and 24 and as further defined in paragraph [0045] of the applicants' specification, organizational

data is stored which comprises “relating the binding information to a sequence location within the set of documents.” For example, as discussed in paragraph [0041] of the applicant’s specification, the operator is provided the opportunity to “indicate where the relevant binding elements begin and end with respect to the document.” Neither of these limitations is disclosed by either the Koga or the Akabane reference.

Conversely, the Koga system merely saves a location where a staple is to be placed in the sheets output to the bin. (See Col. 2, lines 13-16, Col. 9, lines 10-22, and Col. 9, lines 45-48 of the Koga reference). The arguments expressed in the advisory action continue to extend the Koga reference far beyond anything disclosed or considered. The Koga reference clearly states that it is directed at solving the problem of locating the stapling position for a set of documents outputted from a copier. (See Col. 1, lines 11-23 of the Koga reference). There is no discussion in the Koga reference nor any of the previous office actions as to what benefit would be gained by allowing an operator to store the location of a staple in long-term memory. In fact, the Koga reference forecloses the need to store the position of a staple in a long-term memory by presenting the operator with the choice of where to locate a staple prior to beginning the copy process.

Indeed, the applicants’ respectfully submit that the only way in which the conclusions of the office action as to the obviousness of independent claims 12 and 24 can be reached is through the impermissible use of hindsight. The claimed invention is not simply a “predictable use of prior art elements according to their established functions,” and the office action provides no objective reason to combine their respective teachings to arrive at the claimed invention. “A factfinder should be aware ... of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR*, 127 S. Ct. at 1744.

In the present case, the office action relies on the applicants’ disclosure and/or hindsight to support the obviousness rejection. The office action asserts that including a long-term memory would have been obvious at the time the invention was made despite clear shortcomings in each of the cited references. This is clearly inappropriate, as “the

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." MPEP § 2143. Because the office action cannot support the rejection without relying on the applicants' disclosure and/or hindsight, the rejections are improper and should be withdrawn.

37 C.F.R. § 1.131 Affidavit

The office action of April 11, 2008 finally rejects claims 1-3, 5-9, 17, 39, 41-48, 51-53, 56-60, 63, 64, 67-71, 74, 76, and 78-82 as being obvious in view of various references, primarily U.S. Patent No. 6,115,510 to Koga (the "Koga reference"), U.S. Patent No. 6,950,203 to Akabane (the "Akabane reference"), and U.S. Patent Publication No. 2003/0197896 to Doyle (the "Doyle reference"). The office action notes that the Koga and Akabane references fail to disclose a sequence location and a type of the binding element as claimed, and cites the Doyle reference as disclosing these elements. As evidenced by the attached Declaration of Dennis Brawn, however, the Doyle reference does not qualify as prior art and therefore does not support the rejections. Consequently, the rejections based on the Doyle reference should be withdrawn. Likewise, the Jiang and Murata references do not qualify as prior art, and the rejections to claims 20-23, 37, and 38 based on the Jiang and/or Murata references should also be withdrawn.

Under 35 U.S.C. §102(e), the effective date of an anticipating reference is its U.S. filing date. In the present case, the Doyle reference was filed on March 20, 2003. Similarly, the Jiang reference was filed August 22, 2003 and the Murata reference was filed on October 22, 2002. As demonstrated in the attached affidavit, the applicants conceived of the present invention at least as early as May 15, 2001 as demonstrated by an e-mail communication between inventors discussing the "Copy+" system. After this time, the applicants diligently developed the system until it was reduced to practice in early 2003.

CONCLUSION

In view of the prior date of invention, the applicants respectfully submit that rejections of claims 1-3, 5-9, 17, 20-23, 37-39, 41-48, 51-53, 56-60, 63, 64, 67-71, 74, 76, and 78-82 are overcome. The applicants therefore respectfully request withdrawal of the rejections to the referenced claims under § 103 and allowance of the same. Please contact the undersigned attorney at the address and telephone number noted below with any questions or comments.

Respectfully submitted,

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